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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,711	08/02/2001	Chiaki Kasada	KASADA-4	6303

7590 09/15/2004

Browdy and Neimark
624 Ninth Street NW
Washington, DC 20001-5303

EXAMINER

ANGEBRANDT, MARTIN J

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 09/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/890,711	Applicant(s) KASADA ET AL.	
	Examiner Martin J Angebrannt	Art Unit 1756	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/9/04, 9/16/02, 5/24/02, 8/2/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-13 and 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/01, 5/02 & 9/02</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. The response of the applicant has been received and made of record.
2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-5, drawn to styryl dyes.

Group II, claim(s) 6-13 and 15-20, drawn to light absorbing compositions and optical recording media using styryl dyes.

Group III, claim(s) 14, drawn to methods of making styryl dyes.

3. The inventions listed as Groups III and III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The X references cited on the PCT SERACH REPORT evidence that any feature which unites the inventions fails to make a contribution over the prior art. See PCT rule 13.2

4. A telephone call was made to Anne M. Kornbau on June 9, 2004 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Applicant's election of group II in the reply filed on 07/09/2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The applicant submitted no arguments contesting the propriety of the restriction requirement. The examiner notes that a double patenting rejection could not be made between co-pending applications derived from this application, but the assertion of the applicant that references may applied to only one of the groupings is flawed and is not considered binding or legally sound.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 6-9 and 15-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Please insert - - compositions- - after "light absorbent" to make it clear that these may include more than the styryl dye itself. Based upon the discussion with Anne Kornbau and the general language of the dependent claims adding other compounds, these are interpreted as compositions for the purposes of applying prior art.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 6,9,10 and 13 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Kobayashi et al. '215.

See the benzothiazole styryl dyed gelatin films in table II (col 33). See the gelatin dyed films dyed with the thiazole styryl dye in table 1 (col. 29-30). See the gelatin dyed films dyed with the oxazole styryl dye in table IV (col. 37-38). See the gelatin dyed films dyed with the benzooxazole styryl dye in table V (col. 37-40). See the gelatin dyed films dyed with the benzoindole styryl dye in table VII (col. 45-48). See the gelatin dyed films dyed with the pyridyl styryl dye in table X (col. 53-54). See the gelatin dyed films dyed with the benzopyridyl styryl dye in table XI (col. 55-56) and table XII (col. 57-60). See the benzodiazole styryl dye in example 22, which is disclosed in a methanol solution. Useful groups for the heterocyclic moieties are shown in columns 21-28.

12. Claims 6,9,10 and 13 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Dalzell et al. '182.

See compositions in the table using dyes 5 and 8. (col 10).

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13. Claims 6-13 and 15-20 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Kanno et al. GB 2329751.

See example 1, which uses a benzoindole styryl dye mixed with both a bisdithiolate quencher and a nitroso-(dimethylamino)dipethylamine quencher to form a recording layer, which is applied to a substrate, overcoated with an AlTi reflective layer and a UV curing epoxide protective layer. Example 5 uses plural styryl dyes. Example 6 uses plural quenchers and styryl dyes. The examiner holds that both of the quenchers compounds absorb light in the visible and/or that these or any additional styryl dye in the composition meets the “one or other organic dye compounds sensitive to the visible” limitation. The use of plural styryl dyes is disclosed (27/1-10). The use of quenchers is disclosed. (27/11-29/3)

14. Claims 6,7,9-11,13,15,16 and 19 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Shinkai et al. JP 09-066671.

See example 3 [at 0141], which uses benzoindole styryl dye B-3 [0097] mixed with phthalocyanine dye A-3 [0046]

15. Claims 6,9,10 and 13 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Nakamura et al. JP 03-256790.

See examples in table 2 using benzoxazole styryl dye (D-5) and benzopyridyl styryl dye (D-6) .

16. Claims 6,9,10 and 13 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Endo et al. JP 07-043854.

See example 1-3 using benzopyridyl styryl dyes embraced by formula I or II. (dyes 3, 5, or 8) [0030-0033].

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17. Claims 6,9,10 and 13 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Taniguchi et al. JP 10-151854. (machine translation attached)

See the benzoindole styryl containing optical recording medium is example 4 [0030]. Useful groups for the heterocyclic moieties are shown at [0018]. The addition of other coloring matter is disclosed. [[0023].

18. Claims 6,7,10,11,13,15,16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taniguchi et al. JP 10-151854.

It would have been obvious to add other absorbers to the cited examples based upon the direction to do so within the reference.

19. Claims 6,9,10 and 13 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Miyamoto et al. JP 11-034489. (machine translation attached)

See the benzoindole styryl containing optical recording medium is example 15 [0041]. Useful groups for the heterocyclic moieties are shown at [0047]. The addition of quenchers is disclosed [0021].

20. Claims 6-13 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto et al. JP 11-034489.

It would have been obvious to add quenchers, which also acts as absorbers to the cited examples based upon the direction to do so within the reference.

21. Claims 6,7,10,11,13,15,16 and 19 are rejected under 35 U.S.C. 102(b) as being fully anticipated by JP 11-138992. (machine translation attached)

See the benzoindole styryl containing optical recording medium is example 1 [0056-0069] which also includes a phthalocyanine recording layer disposed atop this. Useful groups for

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the heterocyclic moieties are shown at [0020]. The addition of quenchers is disclosed [0046, 0042]. In this case, the light absorbent is considered to be the laminated films.

22. Claims 6-13 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11-138992.

It would have been obvious to add quenchers, which also acts as absorbers to the cited examples based upon the direction to do so within the reference.

23. Claims 6-13 and 15-19 are rejected under 35 U.S.C. 102(b) as being fully anticipated by JP 11-144313.

See the benzothiazole styryl (1c) containing optical recording medium is example 2 with a stabilizing agent [0049]. Useful groups for the heterocyclic moieties are shown at [0008,0047]. The addition of quenchers is disclosed [0040-0041].

24. Claims 6,9,10 and 13 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Miura et al. JP 63-256945.

See examples in table 1, which use dyes 3,7,13 or 14 (page 6) (pyridine as the moiety phi 2 in the instant claims) Benzothiazole, indole and benzopyridyl are phi 1 moieties.

25. Claims 6-13 and 15-20 are rejected under 35 U.S.C. 102(b) as being fully anticipated by Maeda et al. EP 0224261.

Maeda et al. EP 0224261 teaches various naphthoindoleneic styryl dyes, K may be a heterocyclic or aromatic moiety. (3/5-23). The use of bithiolate anions, which are quenchers is disclosed (page 4 and 11/55-57). The addition of other dyes is disclosed. (page 12/lines 1-3). Dyes 166, 173,174,180,264,265,271,347,354,355,361 had heterocyclic moieties as phi 2. These

are coated as thin films and their absorption measured. The quencher counter-ions are asserted to act as visible absorbers.

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

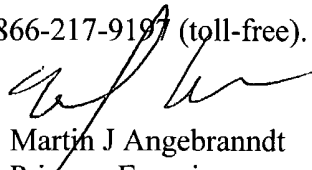
JP 11-314460 and JP 10-188338 teach optical recording media with styryl dyes.

Honda et al. JP 08-179467 teaches styryl dyes in a photographic material.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin J Angebrannndt whose telephone number is 571-272-1378. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Martin J Angebrannndt
Primary Examiner
Art Unit 1756

09/07/2004